

### Remarks

The amendments to the specification presented in Applicants' Response of September 2, 2005 are presented herein again to designate the correct portion of the specification into which the additional paragraph should be inserted.

Claims 1, 5, 19, 30, and 41-42 are pending in this application. Claims 5 and 41 are amended to correct certain typographical errors. No new matter has been added.

Applicants appreciate the Examiner's withdrawal of the rejections previously outstanding under 35 U.S.C. §112. In addition, Applicants respectfully submit that all of the pending claims are allowable for at least the following reasons.

#### A. The Objection to the Disclosure Should Be Withdrawn

On page 2 of the Office Action, the disclosure of this application is objected to because the amendment to the specification whereby Applicants requested insertion of a paragraph designates an incorrect portion of the specification into which such a passage is inserted. Accordingly, Applicants resubmit the amendment herein where the correct portion of the specification is designated. In view of this submission, Applicants respectfully request that the objection of the disclosure be withdrawn.

#### B. The Written Description Rejection Should Be Withdrawn

On page 3 of the Office Action, claims 5, 30, 41 and 42 are rejected under 35 U.S.C. § 112 as allegedly failing to comply with the written description requirement. Specifically, it is alleged that: 1) the definition of R<sup>6</sup> and R<sup>7</sup> in claim 5 is "not described in the specification with respect to the formula where R<sup>6</sup> and R<sup>7</sup> are not in the 3- and 4-positions"; and 2) one of the species recited by claim 41 is not described in the specification. (Office Action, page 3).

First, although Applicants respectfully disagree with the allegation that the definitions of R<sup>6</sup> and R<sup>7</sup> recited by claim 5 is restricted to the structure where R<sup>6</sup> and R<sup>7</sup> are on 3- and 4-positions, claim 5 is amended to replace the current structure with one where R<sup>6</sup> and R<sup>7</sup> are fixed on 3- and 4-positions. In view of this amendment, Applicants respectfully request that the rejection be withdrawn.

Second, with regard to claim 41, the recitation of "N-acetyl-(3-(3-cyclopentyloxy-4-methoxyphenyl)-3-(5-methyl-1,3-dioxoisindolin-2-

yl)propanoylamino)acetate is removed.<sup>1</sup> Accordingly, Applicants respectfully request that this rejection be also withdrawn.

C. The Indefiniteness Rejection Should Be Withdrawn

On page 4 of the Office Action, claims 41 and 42 are rejected under 35 U.S.C. § 112 as allegedly indefinite. In particular, it is alleged that the claims are indefinite based on the assertion that: 1) the recitation of the term “4-methoxyphenyl” in claim 41 is indefinite; and 2) there is insufficient antecedent basis with respect to claim 5 for the term “1,3-dioxobenzo[e]isoindolin-2-yl.” (Office Action, page 4).

With regard to the first allegation, claim 41 is amended to correct the typographical error, *i.e.*, “4-methxoyphenyl” to “4-methoxyphenyl.” Therefore, since the meaning of the term is now clear, Applicants respectfully request that the rejection be withdrawn.

With regard to the second allegation, Applicants respectfully point out that the term “1,3-dioxobenzo[e]isoindolin-2-yl” finds adequate antecedent basis in claim 1. Since claim 41 depends from claim 1 or claim 5, Applicants respectfully submit that the Examiner’s assertion that claim 41 is indefinite with respect to claim 5 is irrelevant.<sup>2</sup> Accordingly, Applicants respectfully request that this rejection be also withdrawn.

Conclusion

In view of the foregoing, Applicants respectfully submit that all of the pending claims are allowable.

---

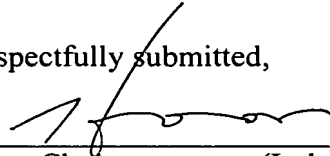
<sup>1</sup> Applicants note that the recitation was actually a typographical error. The species which should have been recited is “N-acetyl-(3-(3-ethoxy-4-methoxyphenyl)-3-(5-methyl-1,3-dioxoisoindolin-2-yl)propanoylamino)acetate,” which is the compound disclosed as Example 11 in the specification. Accordingly, the correct compound is added to claim 41.

<sup>2</sup> Nevertheless, Applicants are willing to separate out the recitation of the compound containing “1,3-dioxobenzo[e]isoindolin-2-yl” moiety and place it in an additional claim depending solely from claim 1. If the Examiner agrees that doing so would obviate the rejection, the Examiner is respectfully invited to contact Attorney for Applicants by telephone.

No fee is believed due for the submission of this paper. If any fees are required for the submission of this paper, or to avoid abandonment of this application, please charge such fees to Jones Day Deposit Account No. 503013.

Date: October 5, 2006

Respectfully submitted,



Hoon Choi (Ltd. Recog. No. L0209)  
**JONES DAY**

*for:* Anthony M. Insogna (Reg. No. 35,203)  
**JONES DAY**  
12750 High Bluff Drive - Suite 300  
San Diego, CA 92130  
(858) 314-1200